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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/717,389

11/19/2003

Donald L. Smothers

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TOD R NISSE
PO BOX 55630
PHOENIX, AZ 85078

EXAMINER

ROGERS, JAMES WILLIAM

ART UNIT

PAPER NUMBER

1618

MAIL DATE

DELIVERY MODE

05/29/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/717,389	Applicant(s) SMOTHERS, DONALD L.	
	Examiner James W. Rogers, Ph.D.	Art Unit 1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) is/are withdrawn from consideration.
- 5) ☐ Claim(s) is/are allowed.
- 6) ☒ Claim(s) 1-2 is/are rejected.
- 7) ☐ Claim(s) is/are objected to.
- 8) ☐ Claim(s) are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. .
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. <u> </u> |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u> </u> | 6) <input type="checkbox"/> Other: <u> </u> |

DETAILED ACTION

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically claims 1 and 2 each claim a composition including an exfoliating composition, a bactericidal composition a blood flow stimulating composition a vasodialating composition and a film forming composition. As currently claimed it is not understood how the foot care composition can include other compositions, it appears as though applicants intended to claim compounds, agents or ingredients within a composition, therefore to expedite the examining process the examiner conducted the search for a composition containing the above ingredients. The claims are also indefinite in respect to the scope of the types of agents that would comprise a film forming agent, an exfoliating agent, a bactericidal agent, a blood flow agent and a vasodialating agent. The examiner suggest including a Markush group supported within the specification for each of the above species to better define the claimed invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2 are rejected under 35 U.S.C. 102(e) as being anticipated by

Drohmann et al. (US 7,147,842 B2).

Drohmann teaches polymers with film forming properties for use in numerous applications including cosmetics and foot care compositions. See col 1 lin 1-3 and col 20 lin 51-55. The compositions can include numerous ingredients including 1 to 99.9% water, organic solvents including ethanol (a known vasodilator and bactericide), bodying agents including guar gum and polyvinyl alcohol (defined in applicants specification as exfoliating agents) preservatives which can also have antimicrobial properties and perfume oils such as sage (defined in applicants specification as a blood flow stimulating compound). See col 12 lin 27-37, col 16 lin 12-31, col 17 lin 20-col 18 lin 11. Regarding the limitation in claim 2 c) and d) it is considered inherent by the examiner that a composition with a film forming polymer will form a film on the skin especially when used in combination with volatile solvents such as water and ethanol which will evaporate. It is also inherent that the film formed will be rubbed off along with dead skin cells, through routine washing and drying by the person applying the composition. It appears as though applicants are trying to claim a new use of an old composition. Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established, Thus the claiming of a new use, new function or unknown property which is

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inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gonzalez et al. (US 6,531,118 B1) in view of Drohmann et al. (US 7,147,842 B2).

Gonzales discloses topical compositions, one of the disclosed uses is a foot care product. See abstract and claims 1-2 and 16. The composition comprises a film former that leaves a protective film on the surface of the skin either immediately or upon evaporation of the volatiles in the composition. See col 7 lin 63-67. The examiner considers it obvious that the film can and will be rubbed off along with dead skin cells through routine washing and drying by the person applying the composition. The composition can further contain vehicles acceptable for topical use including water and

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solvents including alcohols such as ethanol (a known vasodilator and bactericide), antiseptics, antimicrobials and exfoliates. See col 6 lin 46-53 and col 7 lin 41-49.

Gonzalous is silent on the use of blood flow stimulating compounds as defined in applicant's specification such as sage or chamomile.

Drohmann is disclosed above and is used primarily for the disclosure within that compositions useful for foot treatments were already well known at the time of the invention to include sage oil. While sage oil is used for another purpose within the Drohmann patent (perfume oil) the same compound will obviously have the same properties, therefore Dromann meets applicants limitation of a blood flow-stimulating agent because the same compound will obviously have the same properties.

It would have been prime facie obvious to a person of ordinary skill in the art at the time the claimed invention was made to combine the art described in the documents above because Gonzalous discloses topical compositions useful in foot treatments containing all of applicants claimed ingredients except for a vasodilator such as sage extract while Dromann disclosed that sage oil was already known to be used in foot treatment compositions as a perfume oil. The motivation to combine the above documents would be to form a film forming topical composition useful for treating feet with a perfume oil incorporated therein with the advantage of a pleasant odor provided by the sage oil. One of ordinary skill in the art could see that the two references above could be combined because they are related to the same field of endeavor, topical compositions useful in foot treatment and the references contain several identical ingredients such as film-formers, organic alcohol solvents and water therefore one of

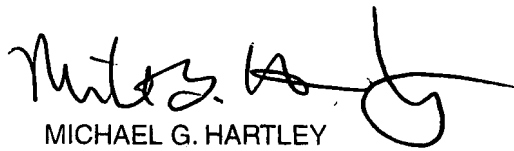
ordinary skill in the art would assume that the ingredients disclosed in one reference could be combined with the ingredients of the other reference. Thus, the claimed invention, taken as a whole was *prima facie* obvious over the combined teachings of the prior art.

Conclusion

No claims are allowed. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James W. Rogers, Ph.D. whose telephone number is (571) 272-7838. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


MICHAEL G. HARTLEY
SUPERVISORY PATENT EXAMINER